

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 26

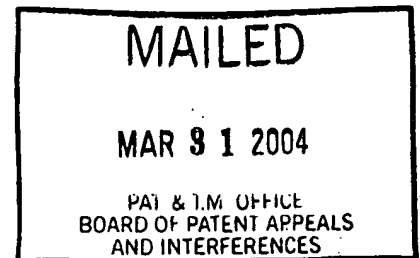
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte KEVIN H. GILLESPIE

Appeal No. 2004-0164
Application No. 09/458,415

ON BRIEF



Before PAK, OWENS and JEFFREY T. SMITH, *Administrative Patent Judge*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

Decision on appeal under 35 U.S.C. § 134

Applicant appeals the decision of the Primary Examiner's refusal to allow claims 1 to 8 and 47-76, all of the pending claims in the application. We have jurisdiction under 35 U.S.C. § 134.¹

¹ In rendering this decision, we have considered Appellant's arguments presented in the Brief filed November 29, 2002 and the Reply Brief filed April 16, 2003.

THE INVENTION

The Appellant's claimed invention relates to a shoe outsole for a baby shoe. According to Appellant, the outsole is suited to facilitate the walking of a first walker by mimicking the barefoot gait of the first walker. (Brief, p. 2). Claim 1 and 47 which are representative of the invention are reproduced below:

1. A shoe outsole for a baby shoe, comprising:

an outer member including an inner heel region; and

an inner member located in the inner heel region and including a ground contacting surface, the inner member having a softer durometer than the outer member;

the shoe outsole being dimensioned for use in a baby shoe, and the inner member being positioned and dimensioned to fit under a baby's heel during use of the baby shoe.

47. A shoe outsole for a baby shoe, comprising:

an outer member;

an inner member, located in an inner heel region of the shoe outsole; and

an intermediate member located in an intermediate region of the shoe outsole, between the outer member and the inner member,

the intermediate member having a softer durometer than the outer member, and including a plurality of ridges, and

the inner member including a ground contact surface, and having a softer durometer than the outer member;

the shoe outsole being dimensioned for use in a baby shoe, and the inner member being positioned and dimensioned to fit under a baby's heel during use of the baby shoe.

CITED REFERENCES

As evidence of unpatentability, the Examiner relies on the following references:

Lennihan, Jr. (Lennihan)	5,875,568	Mar. 02, 1999
Turner	Des. 417,946	Dec. 28, 1999
Tomat	6,092,251	Jul. 25, 2000
Patterson et al. (Patterson)	6,176,025	Jan. 23, 2001

The Examiner rejected claims 1 and 4 to 7 under 35 U.S.C. § 102(e) as anticipated by Tomat; claims 2 and 3 under 35 U.S.C. § 103(a) as obvious over the combination of Tomat and Patterson; claim 8 under 35 U.S.C. § 103(a) as obvious over the combination of Tomat and Lennihan; claims 47, 49 to 59, 61 to 65 and 69 to 73 under 35 U.S.C. § 103(a) as obvious over the combination of Tomat and Turner; claims 60, 66, 74 and 75 under 35 U.S.C. § 103(a) as obvious over the combination of Tomat, Turner and Lennihan; claim 76 under 35 U.S.C. § 103(a) as obvious over Tomat. (Answer, pp. 3 to 8).

OPINION

The review of the grounds of rejection of the appealed claims necessarily entails the interpretation of the scope of the appealed claims. *See In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990). In the present case, the independent claims 1, 47 and 48 all include the preamble phrase “for a baby shoe”. The body of each claim specifies that the shoe outsole is dimensioned for use in a baby shoe. Thus, in the present case, the outsole structure, i.e., dimensioned for use in a baby shoe, cannot be ignored. While the claims include other requirements for the outsole, the language for a baby shoe recited in the preamble does limit the structure (dimension) of the outsole. Thus, we find that claims 1, 47 and 48, all of the independent claims, are directed to a shoe outsole dimensioned for a baby shoe.

The rejection under §102

The Examiner in the rejection of claims 1 and 4 to 7 under § 102 did not consider the preamble language of the claims. The Examiner has not

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identified a portion of the Tomat reference which specifies the dimensions of the shoe outsole. In order for a claimed invention to be anticipated under 35 U.S.C. § 102, all of the elements of the claim must be found in one reference. *See Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

The Examiner in the Answer, page 8, states “[s]ince shoes are typically made of different lengths, widths or sizes, it would be obvious to one of ordinary skill in the art to make the sole of Tomat in the sizes necessary to fit a multitude of different sized feet.” We reverse the rejection because obviousness is not anticipation as required by §102.

The rejections under §103

Because the issues are not ripe for appeal, we remand. The review of the grounds of rejection of the appealed claims necessarily entails the interpretation of the scope of the appealed claims. *See In re Morris, supra*. The present record is clear that the Examiner has not considered the preamble language of the independent claims. The present record does not contain a discussion of whether the references cited by the Examiner contain evidence that would have rendered the dimensional characteristic of the claimed invention obvious. The Examiner should also determine if it is appropriate to reject the subject matter of claims 1 and 4 to 7 under §103.

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In light of the above, we feel it is premature to decide the issues of obviousness in this appeal. Under the present circumstances, the Examiner is required to provide an analysis of the prior art to determine if the claimed subject matter is patentable the cited prior art.

If the Examiner makes any new material factual findings to maintain the Section 103 rejections of record, such rejections constitute new grounds of rejection. Under such circumstances, the Examiner should not provide a Supplemental Answer pursuant to 37 CFR § 1.193(b)(1) (1998). Rather, the Examiner must reopen the prosecution of the application to provide Appellant a full and fair opportunity to respond the new rejections.

CONCLUSION

In summary, the rejection of claims 1, 4 to 7 under §102 is reversed and the instant application is remanded to the Examiner to consider the aforementioned issues and to act accordingly.

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APPROPRIATE ACTION


We remand this application to the Examiner for action consistent with the above.

This application, by virtue of its “special” status requires an immediate action. MPEP § 708.01 (8th ed., Rev. 1, Aug. 2001). It is important that the Board be informed promptly of any action affecting the appeal in this case (e.g., abandonment, issue, reopening prosecution).

REVERSED and REMAND


CHUNG K. PAK
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge


JEFFREY T. SMITH
Administrative Patent Judge

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